

PATENT
Application 10/748,955
Attorney Docket 2001-0341 (1014-045)

REMARKS

Applicant respectfully thanks the Examiner for the consideration provided to this application, and respectfully requests reconsideration of this application.

Each of claims 2, 4, 5, 14, and 19 has been amended for at least one reason unrelated to patentability, including at least one of: to explicitly present one or more elements, limitations, phrases, terms and/or words implicit in the claim as originally written when viewed in light of the specification, thereby not narrowing the scope of the claim; to detect infringement more easily; to enlarge the scope of infringement; to cover different kinds of infringement (direct, indirect, contributory, induced, and/or importation, etc.); to expedite the issuance of a claim of particular current licensing interest; to target the claim to a party currently interested in licensing certain embodiments; to enlarge the royalty base of the claim; to cover a particular product or person in the marketplace; and/or to target the claim to a particular industry.

Claims 1-20 are now pending in this application. Each of claims 1, 19, and 20 is in independent form.

I. The Objection to the Specification

The Specification was objected to under 37 CFR 1.75(d)(1) for allegedly failing to provide proper antecedent basis for the claimed subject matter of the "machine readable medium" as recited in claim 19. This objection is respectfully traversed as moot in view of the present amendments to claim 19, which has been amended to use the substantially equivalent phrase "memory device", thereby not narrowing the scope of claim 19.

The phrase "memory device" finds clear support in the specification as originally submitted at least at paragraph 56 and is defined to mean:

any hardware element capable of data storage, such as for example, a non-volatile memory, volatile memory, Random Access Memory, RAM, Read Only Memory, ROM, flash memory, magnetic media, a hard disk, a floppy disk, a magnetic tape, an optical media, an optical disk, a compact disk, a CD, a digital versatile disk, a DVD, and/or a raid array, etc.

For at least these reasons, reconsideration and withdrawal of the objection to the specification is respectfully requested.

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II. The Obviousness Rejections

Each of claims 1-20 was rejected under 35 U.S.C. 103(a) as being obvious, and thus unpatentable, over various combinations of U.S. Publication 2004/0004968 ("Nassar"), U.S. Publication 2003/0148777 ("Watanabe"), U.S. Patent 6,374,307 ("Ristau"), U.S. Patent 6,028,984 ("Kimball"), U.S. Publication 2002/0131123 ("Clark"), U.S. Patent 6,938,079 ("Anderson") and/or U.S. Patent 6,028,984 ("Nonomura"). Each of these rejections is respectfully traversed.

A. Legal Standards

1. Overview of *Prima Facie* Criteria for an Obviousness Rejection

The Patent Act, namely, 35 U.S.C. 103, forbids issuance of a patent when "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art."

Relatively recently, in *KSR International Co. v. Teleflex, Inc.*, 550 U.S. ___, 127 S. Ct. 1727, 2007 U.S. LEXIS 4745 (2007), the Supreme Court interpreted this law while highlighting the typical invention process. "**Inventions** usually rely upon building blocks long since uncovered, and claimed discoveries **almost necessarily will be combinations** of what, in some sense, is already known" (emphasis added). Yet, to properly apply §103, the Court recognized the need to filter, via obviousness analyses, true inventions from mere ordinary technological advances. "Granting patent protection to advances that **would occur in the ordinary course** without real innovation retards progress and may, in the case of patents combining previously known elements, deprive prior inventions of their value or utility" (emphasis added).

In *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), the Supreme Court established factors regarding the factual inquiry required to establish obviousness. The factors include:

1. determining the scope and contents of the prior art;
2. ascertaining differences between the prior art and the claims at issue;
3. resolving the level of ordinary skill in the pertinent art; and

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4. considering objective evidence indicating obviousness or nonobviousness.

Regarding proposed combinations of prior art, *KSR* clarified that the “[t]he question is not whether the combination was obvious to the patentee but whether the combination was obvious to a person with ordinary skill in the art”. Thus, in determining obviousness, both *KSR* and *Graham* warned against a “temptation to read into the prior art the teachings of the invention in issue” and instruct to “guard against slipping into the use of hindsight”.

KSR further warned, “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art”. The Federal Circuit has held that “[w]hen there is a design need or market pressure to solve a problem”, obviousness is not supported unless “a finite, and in the context of the art, small or easily traversed, number of options” “would convince an ordinarily skilled artisan of obviousness”. *Ortho-McNeil Pharmaceutical Inc. v. Mylan Laboratories Inc.*, 520 F.3d 1358 (Fed. Cir. 2008).

To guard against hindsight, *KSR* explained the “import[ance]” of “identify[ing] **a reason that would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**” (emphasis added). That is, “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some **articulated reasoning** with some rational underpinning to support the legal conclusion of obviousness” (quoting *In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006) (emphasis added)). Thus, “[t]o facilitate review, this analysis should be made explicit”.

Explaining the need for “**a reason that would have prompted** a person of ordinary skill”, *KSR* further taught that “if a **technique** has been used to improve one device, and a person of ordinary skill in the art **would recognize** that it would improve similar devices in the same **way**, using the technique is obvious unless its actual application is beyond his or her skill” (emphasis added). Further exploring this mandate, the Federal Circuit has recently recognized that “knowledge of a problem and motivation to solve it are entirely different from motivation to combine particular references”. *Innogenetics v. Abbott Laboratories* (Fed. Cir. 2007-1145) (8 January 2008).

Thus, according to the Supreme Court, a proper obviousness rejection must “identify **a reason that would have prompted** a person of ordinary skill in the relevant field to combine

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the elements in the way the claimed new invention does” and must present substantial evidence that one of ordinary skill **WOULD** recognize that alleged reason for making the particular claimed combination. It follows that if the alleged reason for making the particular combination of features is not evidenced to be art-recognized, then that reason **MUST BE** based on hindsight.

In addition to establishing a proper reason to combine, a proper obviousness rejection must clearly identify proposed reference(s) that:

1. are pertinent;
2. provide a reasonable expectation of success; and
3. teach... all the claim limitations

See MPEP 2143; MPEP 2143.03, *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); and additional citations *infra*.

Consistent with other patentability rejections, to establish a *prima facie* case of obviousness, substantial evidence must be provided that fulfills the mandates of the applicable law. The “Patent Office has the initial duty of supplying the factual basis for its rejection.” *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (CCPA 1967), *cert. denied*, 389 U.S. 1057, *reh’g denied*, 390 U.S. 1000 (1968). “It may not... resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis”. *Id.*

It is legal error to “substitute[] supposed *per se* rules for the particularized inquiry required by section 103. It necessarily produces erroneous results.” *See, In re Ochiai*, 71 F.3d 1565, 1571, 37 USPQ2d 1127, 1132-33 (Fed. Cir. 1998); *In re Wright*, 343 F.2d 761, 769-770, 145 USPQ 182, 190 (CCPA 1965).

“Once the examiner... carries the burden of making out a *prima facie* case of unpatentability, ‘the burden of coming forward with evidence or argument shifts to the applicant.’” *In re Alton*, 76 F.3d 1168, 37 USPQ2d 1578 (Fed. Cir. 1996) (*quoting In re Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444).

2. Inherency

Inherency “requires that the missing descriptive material is ‘necessarily present,’ not merely probably or possibly present, in the prior art.” *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295, 63 USPQ2d 1597, 1599 (Fed. Cir. 2002).

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3. Unfounded Assertions of Knowledge

Deficiencies of the cited references can not be remedied by general conclusions about what is basic knowledge or common sense to one of ordinary skill in the art. *In re Zurko*, 258 F.3d 1379, 1385-86 (Fed. Cir. 2001). An assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. *Id.* That is, such unfounded assertions are not permissible substitutes for evidence. *See, In re Lee*, 277 F.3d 1338, 1435, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002).

4. Determination of the Level of Skill

Under *Graham*, the required "factual determinations underpinning the legal conclusion of obviousness include 1) the scope and content of the prior art, 2) the level of ordinary skill in the art, 3) the differences between the claimed invention and the prior art, and 4) evidence of secondary factors, also known as objective indicia of non-obviousness." *Eisai Co. Ltd. v. Dr. Reddy's Laboratories, Inc.*, 2008 WL 2791884 (Fed. Cir. 2008), citing *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). "The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry." *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718, 21 USPQ2d 1053, 1057 (Fed. Cir. 1991). Thus, the "examiner must ascertain what would have been obvious to one of ordinary skill in the art at the time the invention was made, and 'not to the inventor, a judge, a layman, those skilled in remote arts, or to geniuses in the art at hand'." MPEP 2141.03, quoting *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 218 USPQ 865 (Fed. Cir. 1983), cert. denied, 464 U.S. 1043 (1984).

5. Next Office Action

If an Office Action fails to set forth sufficient facts to provide a *prima facie* basis for the rejections, any future rejection based on the applied reference will necessarily be factually based on an entirely different portion of that reference, and thus will be legally defined as a "new grounds of rejection." Consequently, any Office Action containing such rejection can not properly be made final. *See, In re Wiechert*, 152 USPQ 247, 251-52 (CCPA 1967) (defining "new ground of rejection" and requiring that "when a rejection is factually based on an entirely

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different portion of an existing reference the appellant should be afforded an opportunity to make a showing of unobviousness vis-a-vis such portion of the reference”), and *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (CCPA 1967) (the USPTO “has the initial duty of supplying the factual basis for its rejection”).

B. Analysis

1. Claims 1-20

a. Inherency

Regarding the application of certain applied portions of Nassar purporting to reject each of independent claims 1, 19, and 20, from one of which each of claims 2-18 ultimately depends, the present Office Action states (emphasis added):

[i]n response to an user’s request for at least one service relating to a service provider’s network, providing an agent for installation on the user’s premises and for coupling to the service provider’s network via a physical connection (see Fig. 1, ‘Router’ 115, acting as a DHCP relay ‘agent’, see ¶0029, also the examiner notes that router 115 is inherently installed on the user’s premises (see ¶0009, wherein the router is located at the border between the local network of the subscriber [read as the user’s premises] and an access network of the home service provider) in response to a user’s desire for accessing a home service provider’s access network, Fig. 1, ref. 170);

Automatically detecting at the agent an installation of a communications device (see Remote Machine Fig. 1, ref. 110 and 111 and ¶0027) to a local network coupled to the agent (see Fig. 1 and ¶0033, wherein the remote machines 110 and 111 are in communication with the router 115 via the local network of the subscriber, thus inherently the router 115 (read as an agent) has automated instructions for detecting the presence of the remote machines 110 and 111 in order to communicate with them);

No substantial evidence has been presented that the admittedly “missing descriptive material is ‘necessarily present’” in Nassar. Applicant respectfully requests provision of evidence supporting the assertion that “router 115 is inherently installed on the user’s premises”

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and that “**inherently** the router 115 (read as an agent) has automated instructions for detecting the presence of the remote machines 110 and 111 in order to communicate with them.”

To the extent that the present Office Action or any future Office Action intends to rely on inherency or Official Notice to support a claim rejection, Applicant respectfully traverses, respectfully requests provision of proper evidence supporting such rejection, and respectfully requests a detailed explanation of how the “missing descriptive material is necessarily present, not merely probably or possibly present”, in any prior art reference cited to support such rejection.

b. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

c. *Missing Claim Limitations*

Each of independent claims 1 and 19, from one of which each of claims 2-18 ultimately depends states, *inter alia*, yet no substantial evidence has been presented that the applied portions of the relied-upon references teach, “automatically detecting at the agent an installation of a communications device to a local network coupled to the agent”.

Claim 20 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of the relied-upon references teach, “said agent comprising a detector adapted to automatically detect an installation of an communications device on a local network coupled to said agent”.

Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), no substantial evidence has been presented the applied portions of the references relied upon in the Office Action, as **attempted to be modified and/or combined**, expressly or inherently teach every limitation of the independent claims, and consequently the Office Action fails to establish a *prima facie* case

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of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

d. Lack of Required Factual Evidence of Obviousness

Applicant respectfully notes that the present Office Action fails to present any explicit factual determinations of the scope and contents of the prior art as required under *Graham*. The present Office Action fails to even identify what "the pertinent art" is. Moreover, the present Office Action fails to present any explicit factual determinations of the level of ordinary skill in the pertinent art.

Applicant respectfully traverses the failure of the present Office Action to comply with the requirements of *Graham* and thereby, to provide a *prima facie* rejection under 35 U.S.C. 103.

e. Lack of Evidence of a Reason to Combine References

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combinations of the applied portions of the relied-upon references, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of Nassar and Watanabe, that are used in rejecting each of claims 1, 19, and 20, in such a manner so as to arrive at the claimed subject matter of each of claims 1, 19, and 20. Regarding the proffered combination of the applied portions of Nassar and Watanabe, the present Office Action states, at Page 4:

[o]ne of skill in the art would have been motivated to modify the teachings of Nassar with the teachings of Watanabe, for including an application awareness application for detecting a type of application running on a communications device and providing a service option related to the type of application. The motivation for doing so would have been to provide a user with service options that match a quality of service requirement associated with applications running on remote machines 110 and 111 of Page 4 Nassar's invention.

The present Office Action presents no evidence that the proffered combination of elements, selected by the Office from the applied portions of the relied-upon references to arrive at the claimed subject matter are "a finite, and in the context of the art, small or easily traversed,

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number of options” that “would convince an ordinarily skilled artisan of obviousness”. Moreover, the present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that **would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would** recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of each of claims 1, 19, and 20 cannot be sustained based upon the mere conclusory statements of the present Office Action.

f. Conclusion

For at least these reasons, Applicant respectfully requests a reconsideration and withdrawal of each rejection of each of claims 1, 19, and 20. Also, reconsideration and withdrawal of each rejection of each of claims 2-18, each of which ultimately depends from independent claim 1 is also respectfully requested.

2. Claims 2, 4, 5, and 14

The rejections of each of claims 2, 4, 5, and 14 are respectfully traversed as moot in view of the present claim amendments.

Specifically, claim 2 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of the relied-upon references teach, “the communications device being a telephone lacking a display, the plurality of user-selectable service options related to non-visual user interface services, the non-visual user interface services comprising spoken command services for caller ID.”

Claim 4 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of the relied-upon references teach, “before registration of the communications device

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with the service provider's network, detecting the at least one capability of the communications device, the plurality of user-selectable service options comprising downloading an updated user manual."

Claim 5 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of the relied-upon references teach, "the communications device being a telephone coupled to the service provider's network via a cable modem, the plurality of user-selectable service options comprising a competitive local exchange carrier telephone service."

Claim 14 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of the relied-upon references teach, "wherein the communications device is a telephone lacking a display, the plurality of user-selectable service options related to non-visual user interface services, the non-visual user interface services comprising push button services for caller ID."

For at least these reasons, Applicant respectfully requests a reconsideration and withdrawal of each rejection of each of claims 2, 4, 5, and 14.

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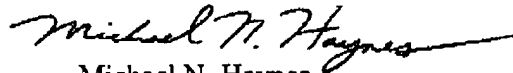
CONCLUSION

It is respectfully submitted that the application is in clear condition for allowance. Reconsideration, withdrawal of all grounds of rejection, and issuance of a Notice of Allowance are earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. 1.16 or 1.17 to Deposit Account 50-2504. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,

Michael Haynes PLC



Michael N. Haynes

Date: 04 November 2008

USPTO Registration: 40,014

Telephone: 434-972-9988

Facsimile: 815-550-8850

1341 Huntersfield Close

Keswick, VA 22947